

REMARKS

Claims 1 and 3-14 are pending in this application. Claim 2 has been cancelled without prejudice or disclaimer. Claims 1 and 3-10 are amended herein. Claims 11-14 are added herein. Support for the amendments to the claims, as well as for the new claims, may be found in the claims as originally filed, and at page 42 of the specification. Reconsideration is requested based on the foregoing amendment and the following remarks.

Objections to the Specification:

The Specification has been objected to for various informalities. The specification was amended in accordance with the Examiner's suggestions. The Examiner's suggestions are appreciated. Withdrawal of the objection is earnestly solicited.

Claim Rejections - 35 U.S.C. § 101:

Claims 9 and 10 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter because they were not embodied in any computer readable medium. The rejection is traversed.

As provided in Ex parte Lundgren, Appeal No. 2003-2088 (BPAI 2005)

"Our determination is that there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101. We decline to create one. Therefore, it is apparent that the examiner's rejection cannot be sustained."

There is thus no need for claims 9 and 10 to be "embodied in any computer readable medium," to be directed to statutory subject matter, contrary to the assertion at page 3 of the Office Action. Furthermore, 35 U.S.C. § 101 provides,

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Furthermore, as provided in State Street Bank and Trust Co. v. Signature Financial Group Inc (149 F. 3d 1368, 1375 (Fed.Circ. 1998),

Today, we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces "a useful, concrete and tangible result"-a final share price momentarily fixed for recording and reporting purposes

and even accepted and relied upon by regulatory authorities and in subsequent trades.

Since claims 9 and 10 do produce a useful, concrete, tangible result, i.e. a method of selling products online, claims 9 and 10 are directed to statutory subject matter within the provisions of State Street.

Furthermore, as provided in State Street,

The plain and unambiguous meaning of § 101 is that any invention falling within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in Title 35, i.e., those found in §§ 102, 103, and 112, ¶12.

Since claims 9 and 10 do fall within one of the four stated categories of statutory subject matter, claims 9 and 10 are directed to statutory subject matter within the provisions of State Street.

In particular, claims 9 and 10 recite a method of selling products online, which falls at least within the "process" category of statutory subject matter provided for by 35 U.S.C. § 101.

Furthermore, as provided in State Street,

The repetitive use of the expansive term "any" in § 101 shows Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in § 101. Indeed, the Supreme Court has acknowledged that Congress intended § 101 to extend to "anything under the sun that is made by man." Diamond v. Chakrabarty, 447 U.S. 303, 309 (1980); see also Diamond v. Diehr, 450 U.S. 175, 182 (1981).

Since Congress intended § 101 to extend to "anything under the sun that is made by man", claims 9 and 10 must have been directed to statutory subject matter within the provisions of State Street. Finally, as provided in State Street,

Thus, it is improper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations. See Chakrabarty, 447 U.S. at 308 ("We have also cautioned that courts 'should not read into the patent laws limitations and conditions which the legislature has not expressed.'" (citations omitted)).

Since it is improper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations, the further requirement listed at page 3 of the Office Action are unlawful and ought to be withdrawn. Claims 9 and 10 are thus submitted be directed to statutory subject matter. Withdrawal of the rejection of claims 9 and 10 is earnestly solicited.

Claim Rejections - 35 U.S.C. § 112:

Claims 9 and 10 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 9 and 10 were amended to make them more definite. Withdrawal of the rejection is earnestly solicited.

Claim Rejections - 35 U.S.C. § 102:

Claims 1, 3, and 5-10 were rejected under 35 U.S.C. § 102(e) as anticipated by US Pat. App. Pub. 2002/0072974 to Pugliese, III et al. (hereinafter "Pugliese"). The rejection is traversed.

Claim 1 recites,

"managing information regarding non-available products in each store, the non-available product being a product that is out of stock."

Pugliese neither teaches, discloses, nor suggests "managing information regarding non-available products in each store, the non-available product being a product that is out of stock," as recited in claim 1. In Pugliese, rather, the *shopper* is left to discover whether a product is available (or not) for himself, by looking for it, not by "managing information regarding non-available products in each store, the non-available product being a product that is out of stock," as recited in claim 1. In particular, as described in the Abstract,

If a shopper does not find the desired merchandise they are referred to another merchant who has the product and the referring merchants receives a commission or other consideration.

Since the *shopper* discovers that the merchandise is lacking in Pugliese, not the merchant, Pugliese does no "managing information regarding non-available products in each store, the non-available product being a product that is out of stock," as recited in claim 1, contrary to the assertion in the Office Action.

Furthermore, even if the terms "non-sellable," and "stock shortage," fell under the definition of availability, as asserted in the Office Action, Pugliese would still not be "managing information regarding non-available products in each store, the non-available product being a product that is out of stock," as recited in claim 1.

In Pugliese, furthermore, the *shopper* is left to discover whether a related or out of stock product, service, or intellectual asset is not available from that merchant, not by "managing information regarding non-available products in each store, the non-available product being a product that is out of stock," as recited in claim 1. In particular, as described in paragraph

[0017],

Someone shopping on a given merchant's site in need of a related or out of stock product, service, or intellectual asset not available from that merchant, is referred to another member merchant that can satisfy the shopper's needs. For example, a shopper purchasing a light fixture, from a ShopLive merchant may need an electrician to install the light.

Since the *shopper* is left to discover that a related or out of stock product, service, or intellectual asset not available from that merchant in Pugliese, not the merchant, Pugliese does no "managing information regarding non-available products in each store, the non-available product being a product that is out of stock," as recited in claim 1, contrary to the assertion in the Office Action.

Claim 1 recites further,

"when a purchaser selects a non-available product from the product catalog of one store, introducing the purchaser to another store in which the product selected by the purchaser is available."

Pugliese neither teaches, discloses, nor suggests "when a purchaser selects a non-available product from the product catalog of one store, introducing the purchaser to another store in which the product selected by the purchaser is available," as recited in claim 1. In Pugliese, rather, walk-in shoppers to a fixed site are restricted to those merchants and product selection available within the specific property, not "when a purchaser selects a non-available product from the product catalog of one store, introducing the purchaser to another store in which the product selected by the purchaser is available," as recited in claim 1. In particular, as described in paragraph [0242],

Walk-in shoppers to a fixed site are restricted to those merchants and product selection available within the specific property.

Since walk-in shoppers to a fixed site are restricted to those merchants and product selection available within the specific property in Pugliese, Pugliese does no "when a purchaser selects a non-available product from the product catalog of one store, introducing the purchaser to another store in which the product selected by the purchaser is available," as recited in claim 1, contrary to the assertion in the Office Action.

Finally, claim 1 recites,

"updating the information regarding non-available products in each store using selection of a product catalog by a purchaser as a trigger."

Pugliese neither teaches, discloses, nor suggests "updating the information regarding non-available products in each store using selection of a product catalog by a purchaser as a trigger," as recited in claim 1. The Office Action asserts at page 5 that the term "purchaser trigger" is equivalent to "operator instruction." This is submitted to be incorrect. An operator instruction, rather, would be discretionary on the part of the operator, i.e. the operator decides when, where, and if to give the instruction. In Pugliese, for example, the operator would presumably issue an instruction to re-stock an item after a customer has asked for it and been disappointed.

"Updating the information regarding non-available products in each store using selection of a product catalog by a purchaser as a trigger," in contrast, would relieve the operator of the need to make the decision. In fact, the operator would not be required at all. As a result, data in a product catalog can be updated at the most appropriate time, i.e. before a customer has asked for it. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 3-6 depend from claim 1 and add further distinguishing elements. Claims 3-6 are thus also submitted to be allowable. Withdrawal of the rejection of claims 3-6 is also earnestly solicited.

Claims 7 and 8:

Claim 7 recites,

"managing information regarding non-available products in each store, the non-available product being a product that stories out of stock."

Pugliese neither teaches, discloses, nor suggests "managing information regarding non-available products in each store, the non-available product being a product that is out of stock," as discussed above with respect to the rejection of claim 1.

Claim 7 recites further,

"performing a shipment process of ordering the product selected by a purchaser from another store in which the product is available to a store in which the product is non-available when the purchaser selects a non-available product from the product catalog of one store."

Pugliese neither teaches, discloses, nor suggests "performing a shipment process of ordering the product selected by a purchaser from another store in which the product is available to a store in which the product is non-available when the purchaser selects a non-available

product from the product catalog of one store,” as discussed above with respect to the rejection of claim 1. Claim 7 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 7 is earnestly solicited.

Claim 8 depends from claim 7 and adds additional distinguishing elements. Claim 8 is thus also submitted to be allowable. Withdrawal of the rejection of claim 8 is earnestly solicited.

Claim 9:

Claim 9 recites,

“managing information regarding non-available products for a plurality of stores.”

Pugliese neither teaches, discloses, nor suggests “managing information regarding non-available products for a plurality of stores,” as discussed above with respect to the rejection of claim 1.

Claim 9 recites further,

“introducing a purchaser to a second store in which a product selected by a purchaser is available when the purchaser selects a non-available product from a catalog of a first store.”

Pugliese neither teaches, discloses, nor suggests “introducing a purchaser to a second store in which a product selected by a purchaser is available when the purchaser selects a non-available product from a catalog of a first store,” as discussed above with respect to the rejection of claim 1. Claim 9 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 9 is earnestly solicited.

Claim 10:

Claim 10 recites,

“managing information regarding non-available products for a plurality of stores.”

Pugliese neither teaches, discloses, nor suggests “manage information regarding non-sellable products for each store, the non-sellable product being a product that cannot be sold at that particular store,” as discussed above with respect to the rejection of claim 1.

Claim 10 recites further,

“shipping a product selected by a purchaser from a second store in which the product selected by the purchaser is available when a purchaser selects a non-available product from a catalog of a first store.”

Pugliese neither teaches, discloses, nor suggests "shipping a product selected by a purchaser from a second store in which the product selected by the purchaser is available when a purchaser selects a non-available product from a catalog of a first store," as discussed above with respect to the rejection of claim 1. Claim 10 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 10 is earnestly solicited.

Claim Rejections - 35 U.S.C. § 103:

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over to Pugliese in view of US Patent No. 5,761,649 to Hill et al. (hereinafter "Hill"). The rejection is traversed. Reconsideration is earnestly solicited.

Claim 4 depends from claim 1 and adds additional distinguishing elements.

Pugliese neither teaches, discloses, nor suggests "said authentication information of said customer is received without passing through said shop computer," as recited in claim 1. Hill does not either, and thus cannot make up for the deficiencies of Pugliese with respect to claim 4.

Finally, the Office Action provides no motivation or suggestion to combine the teachings of Pugliese and Hill, as required by 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D), beyond the assertion that,

"It would have been obvious to someone of ordinary skill in the art to design the system of Pugliese et al. with such a feature as in Hill because the accuracy of the data sent to the customer would no longer depend the distribution of updated disks (Hill, col. 1, lines 32-39) thus, making it easier for customers to obtain accurate information and suppliers to maintain it."

Although this rationale may have been a motivation for modifying *Hill*, there is no reason to suppose that persons of ordinary skill in the art at the time the invention was made would have been motivated to modify *Pugliese* for the reason proposed in the Office Action, because *Pugliese* describes no disks. Persons of ordinary skill in the art cannot improve what does not exist. Claim 4 is thus also submitted to be allowable. Withdrawal of the rejection of claim 4 is earnestly solicited.

New Claims 11-14:

New claims 11 and 12 recite,

"managing information regarding non-available products in each store, the non-available being a product that is out of stock."

None of the cited references disclose “managing information regarding non-available products in each store, the non-available being a product that is out of stock,” as recited in claims 11 and 12.

Claim 11 recites further,

“when a purchaser selects a non-available product from the product catalog of one store, introducing the purchaser to another store in which the product selected by the purchaser is available.”

None of the cited references disclose “when a purchaser selects a non-available product from the product catalog of one store, introducing the purchaser to another store in which the product selected by the purchaser is available,” as recited in claim 11.

Finally, claim 11 recites,

“updating the information regarding non-available products in each store using selection of a product from the product catalog by a purchaser as a trigger.”

None of the cited references disclose “updating the information regarding non-available products in each store using selection of a product from the product catalog by a purchaser as a trigger,” as recited in claim 11. Claim 11 is thus believed to be allowable.

Similarly, claim 12 recites further,

“performing a shipment process of ordering the product selected by a purchaser from another store in which the product is available when the purchaser selects a non-available product from the catalog of one store.”

None of the cited references disclose “when a purchaser selects a non-available product from the product catalog of one store, introducing the purchaser to another store in which the product selected by the purchaser is available,” as recited in claim 12. Claim 12 is thus believed to be allowable.

New claims 13 and 14:

New claims 13 and 14 recite,

“managing information regarding non-available products for a plurality of stores.”

None of the cited references disclose “managing information regarding non-available products for a plurality of stores,” as recited in claims 13 and 14.

Claim 13 recites further,

“introducing a purchaser to a second store in which a product selected by a purchaser is available when the purchaser selects a non-available product from a catalog of a first store.”

None of the cited references disclose “introducing a purchaser to a second store in which a product selected by a purchaser is available when the purchaser selects a non-available product from a catalog of a first store,” as recited in claim 13. Claim 13 is thus believed to be allowable.

Similarly, claim 14 recites further,

“shipping a product selected by a purchaser from a second store in which the product selected by the purchaser is available when a purchaser selects a non-available product from a catalog of a first store.”

None of the cited references disclose “shipping a product selected by a purchaser from a second store in which the product selected by the purchaser is available when a purchaser selects a non-available product from a catalog of a first store,” as recited in claim 14. Claim 14 is thus believed to be allowable.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1 and 3-14 are allowable over the cited references.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Serial No. 10/083,488

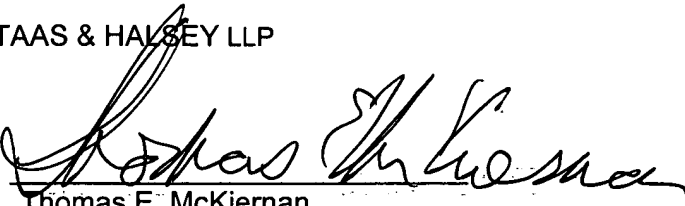
If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: 14 Nov 05

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